

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Initially, the Applicants would like to thank the Examiner for the indication that claim 4 would be allowable if rewritten in independent form.

In the Official Action, the Examiner objects to the Title of the invention as not being descriptive and requires a new Title. In response, the title has been amended to “Holder for a Medical Device--. Accordingly, it is respectfully requested that the objection to the Title be withdrawn.

In the Official Action, the Examiner rejects claims 1-4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner argues that there is no antecedent basis for the terms “the front side,” “the therapeutic device” and “the distal end” in claim 1.¹ In response, such terms appearing in claim 1 have been amended to --a front side--, --a therapeutic device-- and --a distal end--, respectively. Accordingly, it is respectfully requested that the rejection of claims 1-4 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In the Official Action, the Examiner rejects claims 1-3 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,806,822 to Schulz (hereinafter “Schulz”).

In response, Applicants respectfully traverse the Examiner’s rejection under 35 U.S.C. § 102(b) for at least the reasons set forth below.

The Examiner argues that Schulz discloses all of the features of claims 1-3. The Applicants respectfully disagree. Schulz discloses a holder having a fixed portion (12),

¹ Since the term “distal end” does not appear in claim 1, it appears the Examiner is referring to the term “distal portion.”

which attaches to a member (18). Schulz also discloses a holding groove (16) and a holding hole (14). However, although the holding groove (16) is formed further to a front side than the fixed portion (12), the holding hole (14) is not formed further to the front side than the holding groove. As is apparent from the Figures of Schulz, the holding hole and holding groove of Schulz are formed the same distance from the fixed portion (12).

With regard to the rejection of claims 1-3 under 35 U.S.C. § 102(b), a holding device having the features discussed above and as recited in independent claim 1, is nowhere disclosed in Schulz. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”² independent claim 1 is not anticipated by Schulz. Accordingly, independent claim 1 patentably distinguishes over Schulz and is allowable. Claims 2 and 3 being dependent upon claim 1, are thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-3 under 35 U.S.C. § 102(b).

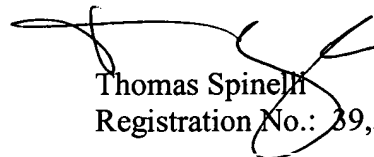
Lastly, Applicants have noticed errors in the disclosure and have corrected the same by way of the present response. With regard to the specification, “insertion portion 3” has been changed to --insertion portion 11-- on line 21 of page 6 and the reference to “Figure 7” at page 11, line 17 and page 12, line 13 has been changed to --Figure 8--. With regard to the drawings, Figures 1, 2, 3, 4 and 10 have been amended to be consistent with the specification. Specifically, Figure 1 has been amended to remove reference numerals 9, 9a, 11a and 11b and to also remove corresponding leader lines since such reference numerals are not recited in the specification, Figure 2 has been amended to include reference numeral 23b

² Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

referenced in the specification and corresponding leader line, Figure 3 has been amended to change one of the reference numerals "21" to --21a-- and to change the corresponding leader line to a dotted line, Figure 4 has been amended to change reference numeral "21" to --21a-- and to change the corresponding leader line to a dotted line and to change reference numeral "22b" to --22c-- and Figure 10 has been amended to change reference numeral "21" to --21a--. Replacement sheets for Figures 1, 2, 3, 4 and 10 showing such changes are enclosed. No new matter has been introduced into the original disclosure by way of such amendments to the specification and drawings.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,


Thomas Spinelli
Registration No.: 39,533

Scully, Scott, Murphy & Presser PC
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343

TS:cm
Encl. (Replacement sheets for Figures 1, 2, 3, 4 and 10)